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Anja Bauer

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EXAMINER

JEAN-LOUIS, SAMIRA JM

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/812,469
Filing Date: March 29, 2004
Appellant(s): BAUER ET AL.

Stephen M. Roylance
Registration No. 31,296
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 04, 2008 appealing from the Office action mailed April 22, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6613338	Schreiber et al.	9-2003
5753212	Pescatore et al.	5-1998
2002/0055562	Butuc, S.	5-2002
5860756	Fabrisi, M.	1-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 18-28 and 32-33, and 36 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Schreiber et al. (U.S. 6,613,338 B1) in view of Pescatore et al. (U.S. 5,753,212).

Schreiber et al. teach a water-in-oil emulsion (see col. 1, line 6) which can be formulated as sticks (instant claim 32) comprising a lipid phase made up of an oil component and a wax component, a 30-85% water (instant claims 21-22), a water-in-oil emulsifier, a stabilizer and further customary cosmetic and/or pharmaceutical auxiliaries, active ingredients and/or additives (instant claims 18 and 36; see abstract and col. 3, lines 33-61). This composition entails a water-in-oil emulsion cosmetic stick (see column 1, lines 1-8), which contains the skin-moisturizing agent glycerol at 2% (see examples 1-27, columns 15-23) (instant claims 18-19 and 36) and additional skin

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moisturizing agents such as glycine and lactic acids in an amount ranging from 0.001-30% (instant claims 18, 20, and 36). Moreover, the work of Schreiber et al. reads upon the majority of the water-in-oil emulsifiers which is embodied by claim 23 and the specific embodiments of claim 24 (see col. 4-6 vs. instant claims 23-24). The work of Schreiber et al. also disclosed the use of polyglyceryl-3-diisostearate, a water-in-oil emulsifier, and the use of a stabilizer in the aforementioned water-in-oil emulsion (see column 5, lines 21-26 vs. instant claim 25; column 6, lines 39-67 and column 7, lines 1-45 vs. instant claims 26-27). Furthermore, the composition of Schreiber et al. may entail pigments and filters (see column 10, lines 55-60 and col. 12, lines 42-43 vs. instant claim 28).

Schreiber et al. do not specifically teach a composition that is spreadable and storage-stable in a temperature range from -10°C to 50°C. Similarly, Schreiber et al. does not teach an emulsion that is solid at room temperature or an emulsion capable of being filled at a temperature of 90°C.

Schreiber et al. does teach that their invention has met the ideal profile of a stick requirement which includes smooth application (i.e. spreadability) and resistance to breaking and temperature without losing oil (instant claim 33; see col. 1, lines 18-23, 42-48, col. 11, lines 31-32 and col. 14, lines 46-50). Moreover, applicant is reminded that a prior art reference may "render obvious" "anticipate" without disclosing a feature of the claimed invention, as long as that missing characteristic is necessarily present, or

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inherent, in the anticipating reference. Please see *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991). Other precedents of the court have held that inherent anticipation does not require that a person of ordinary skill in the art at the time would have recognized the inherent disclosure. Please see, e.g., *In re Cruciferous Sprout Litig*, 301 F.3d 1343, 1351 (Fed. Circ. 2002); *MEHL/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1362, 1366 (Fed. Cir. 1999) (Where the result is a necessary consequence of what was deliberately intended, it is of no import that the article's authors did not appreciate the results". In the instant case, the unappreciated spreadability and storage stability from 10°C-50°C does not require recognition by Schreiber et al. Given that both the prior art and the instant application contains the same ingredients, the cosmetic stick of Schreiber et al. would necessarily be spreadable and storage stable at the same temperature range.

It is further noted that In re Best, 195 USPQ 430, and In re Fitzgerald, 205 USPQ 594, discuss the support of rejections wherein the prior art discloses subject matter which there is reason to believe inherently includes functions that are newly cited or is identical to a product instantly claimed. In such a situation the burden is shifted to the applicants to "prove that subject matter shown to be in the prior art does not possess characteristic relied on" (205 USPQ 594, second column, first full paragraph).

Pescatore et al. teach that cosmetic product in stick form are normally produced where the product is introduced in molten state (i.e. liquefied state) and thereafter

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cooled to produce a final solid stick form (see abstract and col. 1, lines 42-45).

Pescatore et al. further teach that a predetermined quantity of a cosmetic product at its molten temperature is normally introduced through one end and thereafter the cosmetic product is cooled to its non-molten form (i.e. liquid, see col. 1, lines 62-66). Pescatore et al. also teach that the cosmetic product introduced into the body member of the container (i.e. sleeve) is in a molten form at a temperature in the area of 65°C-85°C (instant claim 36-regarding the emulsion being capable of being package at 10°C-50°C; see col. 3, lines 62-65). Pescatore et al. further teach that this product is then cooled (i.e. solidified) at a temperature in the area of 40°C (instant claims 18 and 36). Given that applicant did not point out the criticality of the 90°C temperature, Pescatore et al. necessarily reads on claims 18 and 36 since he teaches that the molten temperature is at about 65°C-85°C and solidifies at a temperature lower than 40°C.

Thus, to one of ordinary skill in the art at the time of the invention would have found it obvious to utilize the composition of Schreiber et al. he teaches a water-in-oil emulsion cosmetic stick containing a lipid phase with oil, wax, a 30-85% aqueous phase, moisturizing agents, and polyglyceryl-3-diisostearate. Given that Schreiber et al. teaches a cosmetic stick of water-in-oil emulsion, and Pescatore et al. teach that such composition is in a molten form at a temperature are of 65°C-85°C and becomes solid at a temperature of 40°C or lower, one of ordinary skill would have been motivated to utilize the composition of Schreiber et al. in light of the disclosure of Pescatore et al.

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with the reasonable expectation of providing a water-in-oil emulsion stick that is moisturizing, spreadable, and storage- stable and comparable to applicant's invention.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over are rejected under 35 U.S.C. 103 (a) as being unpatentable over Schreiber et al. (U.S. 6,613,338 B1, previously cited) in view of Pescatore et al. (U.S. 5,753,212) as applied to claims 18-28 and 32-33, and 36 above and in further view of Butuc (U.S. 2002/0055562 A1).

The Schreiber and Pescatore references are as discussed above and incorporated by reference herein. However, Schreiber and Pescatore do not address the addition of an anti-wrinkle substance in the water-in-oil emulsion stick.

Butuc teaches gel sticks (see page 21, paragraph 122) containing ubiquinone (see page 11, paragraph 50) and anti-wrinkle agents (see page 20, paragraph 118) (instant claim 29)). Butuc has been provided to demonstrate that ubiquinone and anti-wrinkle agents can be added to cosmetic stick in order to beautify and alter appearances.

Thus, to one of ordinary skill in the art at the time of the invention would have found it obvious to add ubiquinone as an anti-wrinkle agent in view of the knowledge of provided by Butuc to the composition of Schreider et al. since Butuc teaches these

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substances as beauty aid ingredients. Given that Schreiber teaches a water-in-oil emulsion stick, and Pescatore et al. teaches that such composition is in a molten form at a temperature are of 65°C-85°C and becomes solid at a temperature of 40°C or lower, and Butuc discloses that ubiquinone and anti-wrinkling agents can also be added to cosmetic sticks for enhanced beauty applications, one of ordinary skill would have been motivated to add ubiquinone and additional anti-wrinkling agents to the composition of Schreiber et al. in light of the disclosure of Butuc with the reasonable expectation of providing a water-in-oil emulsion stick that is moisturizing, spreadable and storage-stable.

Claims 34-35 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Schreiber et al. (U.S. 6,613,338 B1) in view of Pescatore et al. (U.S. 5,753,212) as applied to claims 18-28 and 32-33, and 36 above and in further view of Fabrisi (U.S. 5, 860, 756).

The Schreiber and Pescatore references are as discussed above and incorporated by reference herein. However, Schreiber and Pescatore do not address the water-in-oil emulsion stick in a sleeve-like packaging filled on both sides.

Fabrisi teaches a top-fill/bottom-fill versatile cosmetic carrier for a lipstick container that can be filled either from the top or the bottom (see abstract and col. 2, lines 14-20; instant claim 35). Fabrisi further teaches that such carrier has utility for

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various cosmetics and that this carrier is positioned within a tubular inner sleeve (instant claim 34 see column 4, lines 8-40 and col. 3, lines 43-48).

Thus, to one of ordinary skill in the art at the time of the invention would have found it obvious to add the composition of Schreiber et al. in view of Pescatore et al. into the carrier of Fabrisi to arrive at the composition of applicant in a sleeve like packaging since Fabrisi teaches the use of such sleeve like packaging carriers for better versatility and ease of application. Given that Schreiber teaches a water-in-oil emulsion stick and Fabrisi teaches a tubular sleeve carrier for such composition that is top or bottom filled, one of ordinary skill would have been motivated to add the composition of Schreiber et al. into the carrier of Fabrisi in of his disclosure with the reasonable expectation of providing a water-in-oil emulsion stick that is versatile and easily applicable as is the composition disclosed in applicant's invention.

(10) Response to Argument

(1) Appellants submit that Schreiber neither teaches nor suggest emulsions comprising 5% to 50% by weight of skin moisturizing agent.

While Schreiber does not teach addition of 5-50% moisturizing agent, the Examiner contends that Schreiber does teach addition of moisturizers to his composition (see col. 2, line 22). Additionally, the examples of Schreiber teach addition of 2% glycerol (see examples 1-20 and 22-27), a moisturizing skin agent well-known in the art. Additionally, Schreiber teaches addition of lactic acid and glycine to the

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composition in an amount of 0.001 to 30% (see col. 13, lines 21 and 41 and col. 14, lines 1-5). While glycine and lactic acid were taught by Schreiber as antioxidants, the Examiner asserts that both glycine and lactic acid are well-known in the art as moisturizing skin agents. Moreover, it is the Examiner's contention that a compound's physical property is inseparable from the compound. Thus, Schreiber necessarily teaches the addition of skin moisturizing agents (i.e. lactic acid and glycine) in an amount of 0.001-30% and thus render obvious appellant's limitation of 5-50% by weight of at least one skin moisturizing agent. As for Appellant's arguments that glycerol is in a concentration of 2%, the Examiner contends that given that other moisturizing agents such as lactic acid and glycine are taught by Schreiber in an amount ranging from 0.001-30%, one of ordinary skill in the art would have found it obvious to utilize glycerol in the same amount and that addition of glycerol, lactic acid, and glycine would necessarily result in an amount between 0.001-30%. Regardless if Schreiber suggests addition of moisturizers as optional ingredients, the Examiner contends that one of ordinary skill in the art would have indeed found it obvious to add moisturizers and/or antioxidants into the composition since Schreiber teaches their use in the composition in an amount ranging from 0.001-30% and an amount that overlaps applicant's range. Consequently, Schreiber does indeed render obvious appellant's limitation of 5-30% of a skin moisturizing agent.

(2) Pescatore does not cure the deficiencies of Schreiber. Furthermore, Appellant states that the disclosure of Pescatore does not allow any conclusion as to the properties of the composition of Schreiber.

As previously stated, the Examiner disagrees as Schreiber clearly teaches addition of glycerol in the composition. While glycerol was not added in an amount from 5-50%, Schreiber teaches addition of additional art-recognized skin moisturizing agents such as lactic acid and glycine in an amount ranging from 0.001-30% thus rendering obvious appellant's claim limitation. Pescatore, on the other hand, was provided to demonstrate that cosmetic product in stick form can be prepared in a molten state at a temperature in an area of 65-85°C and solidified at a temperature in the area of 40°C which reads on appellant's limitation of the product being filled at a temperature of 90°C (see col. 1, lines 62-66 and col. 3, lines 62-65). Thus, absent a clear indication from appellant of the criticality of a filled temperature of 90°C, the Examiner contends that Schreiber in view of the disclosure of Pescatore does indeed render obvious applicant's invention. Moreover, given that Schreiber teaches a stick that is applied smoothly and resistant to breaking, the Examiner asserts that such product is indeed spreadable as Schreiber teaches smooth application of the product (see col. 1, lines 18-23 and 42-48; col. 11, lines 31-32, and col. 14, lines 46-50). Importantly, the Examiner asserts that while Schreiber might have not appreciated the spreadability and storage stability of the composition, such property is necessarily present in the product of Schreiber as the prior art and the instant application contain the same ingredients.

(3) Appellants submit that claims 29 and 34-35 are not properly rejected under 35 U.S.C. 103(a). Moreover, Appellants state that Schreiber does not render obvious appellant's invention and thus a *prima facie* case has not been established.

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The Examiner disagrees as claim 29 and 35 both depend from claim 18 which was previously rejection over Schreiber in view of Pescatore. Butuc was provided to demonstrate that stick compositions can contain ubiquinone and anti-wrinkle agents for beautification purposes and for altering appearance (see pg. 11, paragraph 50 and pg. 20, paragraph 118). Thus, Schreiber in view of Pescatore and in further view of Butuc does indeed render obvious claim 29. Likewise, Fabrisi was provided to demonstrate that stick formulations can be top-filled or bottom filled depending on the desired product (see abstract, col. 2, lines 14-20, col. 3, lines 43-48, and col. 4, lines 8-40). Consequently, the Examiner asserts that Schreiber in view of Pescatore and in further view of Butuc and Fabrisi does indeed render obvious Appellant's invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/SREENI PADMANABHAN/

Supervisory Patent Examiner, Art Unit 1617

Conferees:

/Samira Jean-Louis/

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